

ATTORNEY DOCKET NO.
13957.0004

PATENT
Customer ID No. 33649

REMARKS/ARGUMENTS

Claims 1 through 5 and 21 through 29 are pending. Claims 6 through 20 have been cancelled without prejudice or disclaimer, and the Applicants appreciate the Examiner's identification that these claims are drawn to patentably distinct inventions and will file divisional patent applications on these claims. Claims 3-5 stand rejected as allegedly being directed to non-statutory subject matter. Claims 1-5 stand rejected under 35 U.S.C. 112 for noted reasons. Claims 1-5 stand rejected under 35 U.S.C. 102(e) as being anticipated by Bowers. Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Conway. These rejections are respectfully traversed.

Rejections under 35 USC 101

Claims 3-5 stand rejected under 35 U.S.C. 101 because "the invention in the body of the claim is not tied to a technological art, environment, or machine." This rejection is traversed. The Applicants object that the Examiner has imposed requirements for patentability beyond those set forth under law, in particular, that whether the invention is tied to a technological art, environment, or machine is limited to strictly what is in the body of the claim without regard to the claim preamble. The claim preamble may limit a claim, particularly where it "gives life and meaning" to the claim. The creation of a new requirement for patentability by the Examiner is objected to.

Claim 3 includes an "improved method of managing equipment using an equipment management system capable of detecting a portable unique identifier attached to a piece of equipment and maintaining a database of individuals and the equipment issued to the individuals, the system further capable of classifying equipment into equipment groups and individuals into asset creating individuals and non-asset creating individuals the improved method comprising the steps of: in the equipment management system, a) flagging a piece of equipment assigned to an asset-creating individual; b) documenting the occurrence of an asset-creating event; and c) designating said piece of equipment an asset." (Emphasis added). An equipment management system is clearly patentable subject matter – it unquestionably falls within the time-worn definitions of a process or machine. The equipment management system maintains a database, flags a piece of equipment assigned to an asset-creating individual, documents the occurrence of

an asset-creating event, and designates the piece of equipment an asset. In the absence of the invention of claim 3, the authenticity of the piece of equipment would be questionable – each year, billions of dollars are spent on counterfeit sports memorabilia, whereas the invention of claim 3 allows the authenticity of sports memorabilia to be conclusively determined. Thus, the invention of claim 3 meets the requirements of 35 U.S.C. 101 – it is within the technological arts, and produces a useful, concrete and tangible result. If the Examiner persists in the position that the body of the claim alone is the basis by which compliance with 35 U.S.C. 101 is judged, the Applicants would appreciate the citation of binding legal precedent that supports that position – the unpublished opinion cited by the Examiner was not reviewed, as it is not controlling, and the MPEP section cited make no mention of any such requirement, nor are the Applicants aware of any such legal requirement. Withdrawal of this rejection is respectfully requested.

Rejections under 35 USC 112

Claims 1 through 5 stand rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner, the claims are "replete with errors," of which the Examiner only provides "some examples." As discussed below, the Applicants have shown that none of the alleged errors are in fact errors; as such, the Applicants request that the Examiner identify with particularity any other alleged errors, as it is impossible to traverse a rejection when it has not even been identified.

The Examiner asserts that in claim 1, it is unclear if the "asset-creating individual profile" in section h is the same as "an individual profile" in section g. The Examiner correctly notes that the use of the prefix "an" makes them separate – and indeed they are. What is missing from the Examiner's rejection is an explanation of why there is a lack of clarity. A simple example will suffice to show why the claims do not lack clarity.

Elements g and h in claim 1 state "g) assigning said equipment to an individual profile; h) turning an individual flag on for an asset-creating individual profile." Referring to paragraph [0034] of the specification, it states that the "default setting in all individual profiles turns the asset flag off when a piece of equipment is assigned to that individual. For a specifically identified individuals, the default setting is reversed and the asset flag stays turned

on when the equipment is assigned to that individual. Generally, only the team stars would have this asset setting." Thus, after a quick review of the specification, any possible uncertainty is erased – the "an individual profile" is indeed different from "an asset-creating individual profile," and they are indeed separate steps whereby a default setting is reversed for asset-creating individual profiles and the individual flag is turned on. The claims do not incorporate limitations from the specification, but must be read in light of the specification. Doing so removes any alleged problems under 35 U.S.C. 112.

Likewise, the Examiner alleges that it is unclear if step m will occur since step l determines if the equipment is an asset. The Examiner reasons that if the equipment is not an asset, step m will not occur, allegedly making the scope of claim 1 unclear. Turning this time to the preamble, we see that claim 1 is drawn to "method of equipment management and identifying assets for a sports team." The scope of claim 1 is quite clear – it is identifying assets. If the equipment is not an asset, then it falls outside of the scope of the claim. The Applicants have particularly pointed out and distinctly claimed the subject matter regarded as the invention – if an item is not an asset, it falls outside of the scope of claim 1, as made clear in the preamble. The Examiner cannot create indistinctness by expanding the claim beyond its stated scope – if this was the case, every claim would be indistinct, as no claim can describe every possibility and eventuality, such as what might happen under an unusual set of circumstances. The pertinent requirement under 35 U.S.C. 112 is that the applicant "particularly point out and distinctly claim the subject matter which applicant regards the invention." This the Applicants have done, by particularly pointing out and distinctly claiming a method of equipment management and identifying assets for a sports team. The Applicants do not seek to particularly point out and distinctly claim a method of equipment management and identifying non-assets – if the equipment is not an asset, it falls outside of the scope of claim 1. The same arguments also apply to claim 2, as the Examiner applies the same reasoning as the basis for the rejection of claim 2.

In regards to claims 3 and 4, the Examiner has not provided any reasons for the alleged rejections under 35 U.S.C. 112, but states that the rejection will be withdrawn if the rejection under 35 U.S.C. 101 is overcome. Applicants therefore consider this rejection withdrawn, but note that there is no relationship at all between the requirements of 35 U.S.C. 101 and 35 U.S.C. 112 such that withdrawal of a basis for rejection under 35 U.S.C. 101 would also

result in the withdrawal of a basis for rejection under 35 U.S.C. 112. As such, the reasoning behind this rejection is unclear.

In regards to the Examiner's statement regarding claim 5, it seems quite clear that it would not be possible to perform the steps of "e) obtaining the unique identification of the equipment; and f) matching the unique identification of the equipment with provenance information associated with the unique identification through the Internet" unless information on the occurrence of the asset-creating event as set forth in step b) is made retrievable through the Internet. If the Examiner can explain how that could occur, the Applicants might better understand why the Examiner believes this creates a basis for an apparent rejection under 35 U.S.C. 112.

Rejections under 35 USC 102

Claims 1 through 5 stand rejected under 35 U.S.C. 102(e) over Bowers, as the claimed flag setting steps are allegedly inherent in Bowers. The law of inherency is clear – in "relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Although the Examiner has failed to do so, the Applicants will set forth the flag setting steps that are allegedly inherent in Bowers, and will attempt to provide the basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Bowers. These are:

Claim 1:

- e) turning a group flag on for a potential asset group;
- h) turning an individual flag on for an asset-creating individual profile;
- k) turning an event flag on for equipment used in said asset-creating event;
- l) determining if said equipment is now an asset by checking for a group flag, an individual flag and an event flag;

The examiner fails to specifically address where these elements are disclosed in Bowers, but instead builds the following hypothesis in the subsequent sections of the office action, which are not particularly helpful to understanding the basis for the rejection under 35 U.S.C. 102(e):

- An "individual" can be "a distinct entity"
- Nothing in the specification defines "individual" as meaning "person"
- Therefore, a book is an individual.

However, none of this meets that the requirement that the claimed limitation "necessarily flows from the teachings of the applied prior art." As the Examiner admits, "even if not inherent in Bowers '006, Conway teaches the uses of flags in computer systems." This hits the nail right on the head – the claimed flag settings in computer systems are not inherent in Bowers. In particular, "e) turning a group flag on for a potential asset group; h) turning an individual flag on for an asset-creating individual profile; k) turning an event flag on for equipment used in said asset-creating event; l) determining if said equipment is now an asset by checking for a group flag, an individual flag and an event flag" are simply not inherent – some of these steps are even admitted by the Examiner not to be disclosed. For example, the Examiner states that based on his interpretation of the claim language, "the asset creating event is an event which made the patron or library customer famous." (Office Action, page 14). However, the Examiner's own definition of the term "individual" is that it is the book, and not the person. Thus, "h) turning an individual flag on for an asset-creating individual profile" would be construed as "h) turning [a book] flag on for an asset-creating [book] profile." Of course, this is nonsense. What is an asset creating book profile? And more importantly, Bowers fails to disclose it. The rejection of claim 1 under Bowers is simply incorrect, and must be withdrawn.

Likewise for claim 2. Using the Examiner's own definition of "book" for "individual," we see that the relevant steps of claim 2 are "e) turning the asset flag on for said potential asset group; h) turning the flag off for equipment assigned to a non-asset-creating [book] profile; k) determining if said equipment is now an asset by checking for an asset flag turned on and used in an asset-creating event." Equipment assigned to a non-asset-creating book profile? Where is that disclosed in Bowers? Nowhere. For claim 3, we have "a) flagging a piece of equipment assigned to an asset-creating [book]." Again, the same nonsense. Equipment is not assigned to books, and even if it is in some Lewis Carolian universe, it is not in Bowers. Bowers fails as a basis for rejecting the claims under 35 U.S.C. 102(c), and these rejections must be withdrawn.

Rejections under 35 USC 103

Apparently not convinced of the argument that the claimed flags are "inherent" in Bowers, claims 1 through 5 are also rejected over Bowers in view of Conway, as the explicit reference to flags in Conway apparently is supposed to make up for all of the other missing claim elements that are not found in Bowers. As described above, using the Examiner's own claim construction terms results in nonsensical claims covering things like assigning equipment to books. However, rather than drag through the tortured constructions inherent in the Examiner's assertion that an "individual" can be a book, the Applicants draw the Examiner's attention to the numerous references in the specification that an individual is a person. In fact, there is no use to the contrary anywhere in the specification.

For example, consider paragraph 13 of the specification, which states "Next the equipment is issued to an individual. Each piece of equipment is scanned, or identified as it is issued to an individual. Using the input device, the individual's profile is accessed and the piece of equipment is registered to that individual. A time and date stamp is included." What in this paragraph could possibly lead one to believe that an individual is anything other than a person? Just to make this assertion clear for the record, the Applicants clearly define in this file history their intention to be their own lexicographer, and use the term "individual" to refer to a person and not to books, as is clearly reflected and to the extent present in the specification. While the Applicants disagree that this is a definition other than the ordinary meaning, as doing so removes the basis for the Examiner's rejection of the claims under 35 U.S.C. 103 and places them in condition for allowance, the Applicants are glad to do so to expedite prosecution.

New claims 21 through 29, drawn to systems and methods for equipment management, are presented herewith for examination and are believed to fall within the elected inventions as set forth by the Examiner. The Applicants also request that the Examiner take note of the change of address for Applicants' attorney of record.

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CONCLUSION

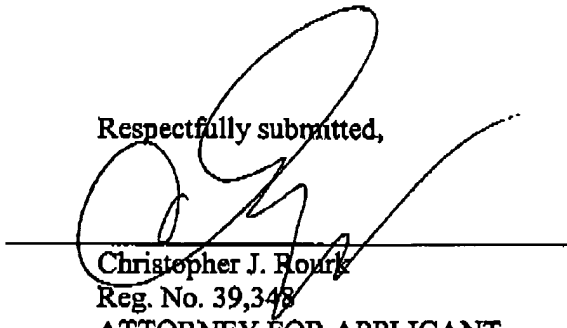
In view of the foregoing remarks and for various other reasons readily apparent, Applicant submits that all of the claims now present are allowable, and withdrawal of the rejection and a Notice of Allowance are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (214) 939-8657 so that such issues may be resolved as expeditiously as possible.

A response to the pending office action within the one-month extension period was due on October 2, which fell on a Saturday. As such, this response is timely filed within the one month extension of time period on Monday, October 4, 2004. An additional fee of \$110 for a one-month extension of time is believed to be due, for which a petition is hereby made, and the Commissioner is hereby authorized to charge this fee to the deposit account of Godwin Gruber LLP, No. 500530. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Godwin Gruber LLP, No. 500530.

Respectfully submitted,

Date: October 4, 2004


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